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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/088,869	07/03/2002	Christer Carlson	13930NP	6753
293	7590	04/22/2004	EXAMINER	
DOWELL & DOWELL PC SUITE 309 1215 JEFFERSON DAVIS HIGHWAY ARLINGTON, VA 22202			BARTH, VINCENT P	
			ART UNIT	PAPER NUMBER
			2877	

DATE MAILED: 04/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/088,869

Applicant(s)

CARLSON, CHRISTER

Examiner

Vincent P. Barth

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 July 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 0302,0803.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 6, 9 and 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
3. Claim 6 is rejected under §112 as indefinite and 37 CFR 1.75(c) as being in improper dependent form, because it depends from itself, rather than from another claim. See also MPEP § 608.01(n). Such dependency is certainly typographical in origin, nevertheless, the claim must be amended. In an effort to forward prosecution, the Examiner has treated Claim 6 below as if its dependency were from Claim 1.
4. Referring to Claim 9, a broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation, in the same claim, is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP §2173.05(c)(I). Thus, the terms “preferably” and “most preferably” render the claim indefinite. Therefore, such dimensions must be rewritten into separate claim if the Application is to proceed further. Nevertheless, the claim has been discussed below as best understood, and in which 300 cm² is the appropriate limitation.
5. Referring to Claim 11, the fourth paragraph of 35 U.S.C. §112 provides that, “A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to

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which it refers". Accordingly, Claim 11 inherits the §112 second paragraph rejection of Claim 9, and is therefore rejected as well. However, Claim 11 also been discussed below, as it may best be understood.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 1-8 and 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Holman, et al., U.S. Pat. No. 4,422,759 (27 Dec. 1983), in view of Flaton, U.S. Pat. No. 4,736,739 (12 Apr. 1988), further in view of Neyman, U.S. Pat. No. 5,917,987 (29 Jun. 1999).

8. Referring to Claims 1, 2, 6 and 8, Holman discloses a device which is described as a photographic accessory (i.e. a reference card) for providing both a scale for objects photographed, as well as color standards (col. 1, lns. 24-29). Holman discloses that the accessory may be in small flexible sheets 20, which pressure sensitive adhesive 23 applied to the back (col. 1, lns. 53-57). Holman does not explicitly disclose that the adhesive is releasable, however, in one embodiment the accessory is adhered to a patient's body (col. 2, lns. 8-11). Since the device in Holman must necessarily be later removed from the patient after surgery,

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such adhesive is also necessarily releasable from the patient without damage. Thus, the adhesive is inherently releasable, since the property of the adhesive necessarily follows from the disclosure. See MPEP §2112. Holman discloses that different colors appear in patches on the accessory (col. 1, ln. 66 to col. 2, ln. 6), although not specifying grey. Neyman discloses a grey scale test chart for photography, with graduations from white to black, each including a predetermined reflectance and including neutral grey (col. 9, lns. 40-55; and Fig. 4). Holman and Neyman are analogous art, since they are from a similar problem solving area, in that each involves photographing a subject and using a reference object to optimize the images from the camera. See Medtronic, Inc. v. Cardiac Pacemakers, 721 F.2d 1563, 1572-1573, 220 USPQ 97, 103-104 (Fed. Cir., 1983). The motivation for combining the reference would have been to include grey scale features of Neyman into the color system of Holman. Accordingly, it would have been obvious to those skilled in the art to combine the references, at the time of the invention, in order to obtain such benefit. Neither Holman nor Neyman disclose that the reference card may be in a roll or a pad. Flaton discloses a flexible reference mat which may be provided stacked in packs (i.e., a pad), or in the form of a perforated roll (col. 1, lns. 44-46). Holman, Neyman and Flaton are analogous art, since they are from a similar problem solving area, in that each involves photographing a subject and using a reference object to optimize the images from the camera. See Medtronic, Inc. v. Cardiac Pacemakers, 721 F.2d 1563, 1572-1573, 220 USPQ 97, 103-104 (Fed. Cir., 1983). The motivation for combining the reference would have been to include the particular dispensing features of Flaton into the combination reference object of Holman and Neyman. Accordingly, it would have been obvious to those skilled in the art to combine the references, at the time of the invention, in order to obtain such

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benefit. Applicant has stated in the instant Specification that the rolls or pads serve particular purposes, which are essentially to preserve the color/grey scale integrity of the reference cards by reducing light exposure, as well as to improve portability (Spec. pgs. 1-2). The Flaton reference does not explicitly state the purpose of providing the reference objects in a roll or pack, however, portability may be reasonably inferred as at least one purpose, whereas sterility and thus disposability being certainly another unstated purpose. In this connection, note that the court in In re Dillon, 16 USPQ 2d 1443 (CAFC 1992) held that it is not necessary for the prior art to have the same or similar utility as one newly discovered by applicant.

9. Referring to Claim 3, neither Holman, Neyman nor Flaton disclose that a field is used for setting the focus and/or centering the pictures. However, Holman discloses sectors 30-33, as well as dimensional graduations (Fig. 1) which those of skill in the art would understand implicitly to be an appropriate means of focusing the camera and/or centering the picture. See MPEP §2144.01.

10. Referring to Claims 4, 5 and 11, Holman discloses that the graduations 26 may be chromatically contrasting, for example white, with varying background colors (col. 1, lns. 57-64). Since Holman discloses the graduations as chromatically contrasting, an alternative embodiment in which the graduations are black with a light background would be obvious to those of skill in the art.

11. Referring to Claim 7, Neyman discloses that the grey scale reference portions of the object are marked with numerals to indicate percentage on a grey scale system (Fig. 4).

12. Referring to Claim 12, the combination of Holman, Neyman and Flaton do not explicitly disclose that the reference objects are stored in a light tight box. However, it has been well

known in the photographic arts that light sensitive materials, including those subject to fading or discoloration, may be protected in a light tight box to prevent such light damage. See MPEP §2144.03.

13. Referring to Claim 13, Holman discloses a device which is described as a photographic accessory (i.e. a reference card) for providing both a scale for objects photographed, as well as color standards (col. 1, lns. 24-29). Holman discloses that the accessory may be in small flexible sheets 20, which pressure sensitive adhesive 23 applied to the back (col. 1, lns. 53-57). Holman does not explicitly disclose that the adhesive is releasable, however, in one embodiment the accessory is adhered to a patient's body (col. 2, lns. 8-11). Since the device in Holman must necessarily be later removed from the patient after surgery, such adhesive is also necessarily releasable from the patient without damage. Thus, the adhesive is inherently releasable, since the property of the adhesive necessarily follows from the disclosure. See MPEP §2112. Holman discloses that different colors appear in patches on the accessory (col. 1, ln. 66 to col. 2, ln. 6), although not specifying grey. Neyman discloses a grey scale test chart for photography, with graduations from white to black, each including a predetermined reflectance and including neutral grey (col. 9, lns. 40-55; and Fig. 4). Holman and Neyman are analogous art, since they are from a similar problem solving area, in that each involves photographing a subject and using a reference object to optimize the images from the camera. See Medtronic, Inc. v. Cardiac Pacemakers, 721 F.2d 1563, 1572-1573, 220 USPQ 97, 103-104 (Fed. Cir., 1983). The motivation for combining the reference would have been to include grey scale features of Neyman into the color system of Holman. Accordingly, it would have been obvious to those skilled in the art to combine the references, at the time of the invention, in order to obtain such

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benefit. Neither Holman nor Neyman disclose that the reference card may be in a roll or a pad. Flaton discloses a flexible reference mat which may be provided stacked in packs (i.e., a pad), or in the form of a perforated roll (col. 1, lns. 44-46). Holman, Neyman and Flaton are analogous art, since they are from a similar problem solving area, in that each involves photographing a subject and using a reference object to optimize the images from the camera. See Medtronic, Inc. v. Cardiac Pacemakers, 721 F.2d 1563, 1572-1573, 220 USPQ 97, 103-104 (Fed. Cir., 1983). The motivation for combining the reference would have been to include the particular dispensing features of Flaton into the combination reference object of Holman and Neyman. Accordingly, it would have been obvious to those skilled in the art to combine the references, at the time of the invention, in order to obtain such benefit. Applicant has stated in the instant Specification that the rolls or pads serve particular purposes, which are essentially to preserve the color/grey scale integrity of the reference cards by reducing light exposure, as well as to improve portability (Spec. pgs. 1-2). The Flaton reference does not explicitly state the purpose of providing the reference objects in a roll or pack, however, portability may be reasonably inferred as at least one purpose, whereas sterility and thus disposability being certainly another unstated purpose. In this connection, note that the court in In re Dillon, 16 USPQ 2d 1443 (CAFC 1992) held that it is not necessary for the prior art to have the same or similar utility as one newly discovered by applicant. Neither Holman, Neyman nor Flaton disclose that a field is used for setting the focus and/or centering the pictures. However, Holman discloses sectors 30-33, as well as dimensional graduations (Fig. 1) which those of skill in the art would understand implicitly to be an appropriate means of focusing the camera and/or centering the picture. See MPEP §2144.01. Holman discloses that the graduations 26 may be chromatically contrasting,

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for example white, with varying background colors (col. 1, lns. 57-64). Since Holman discloses the graduations as chromatically contrasting, an alternative embodiment in which the graduations are black with a light background would be obvious to those of skill in the art.

14. Claims 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Holman, et al., U.S. Pat. No. 4,422,759 (27 Dec. 1983), in view of Flaton, U.S. Pat. No. 4,736,739 (12 Apr. 1988), further in view of Neyman, U.S. Pat. No. 5,917,987 (29 Jun. 1999), further in view of Applicant's admissions of prior art.

15. Referring to Claims 9 and 10, the combination of Holman, Neyman and Flaton discussed above contain all of the claimed limitations, except the particular dimensions of the reference object as claimed. However, Applicant has stated in the instant Specification at page 1, that previously known grey cards are sold in a variety of sizes, one of which is less than 300 cm², namely 130 cm². See MPEP §2129, which states, "When applicant states that something is prior art, it is taken as being available as prior art against the claims.", citing In re Nomiya, 509 F.2d 566, 184 USPQ 607 (1975). In the alternative, such sizes represent non-critical limitations. The Specifications in the instant Application do not disclose why the sizes set forth are a critical limitation over the prior art reference cards as identified in the instant Specification at page 1. Accordingly, this feature would have been obvious to those skilled in the art at the time of the invention. See MPEP §2144.05(III) and §§716.02-716.02(g) for a discussion of criticality and unexpected results.

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16. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Holman, et al., U.S. Pat. No. 4,422,759 (27 Dec. 1983), in view of Flaton, U.S. Pat. No. 4,736,739 (12 Apr. 1988), further in view of Neyman, U.S. Pat. No. 5,917,987 (29 Jun. 1999), further in view of Taub, et al., U.S. Pat. No. 5,984,457 (16 Nov. 1999).

17. Referring to Claim 14, the combination of Holman, Neyman and Flaton discussed above contain all of the claimed limitations, except none discuss the method of making such reference objects. Taub discloses a spray-mode inkjet printer, and that it has been known to use such devices to form opaque color and grey-scale images (col. 1, lns. 8-10; col. 1, lns. 38-40). It would be obvious to those of skill in the art to use such device, if desired, due to the low cost of operation, and variety of colors that such devices may dispose upon a reference object, consistent with the color patches as disclosed in the Holman reference (col. 1, ln. 66 to col. 2, ln. 8). The recitation of the device features in Claim 14 by reference to Claim 1 is a non-limiting statement of intended use, which does not distinguish the invention over the prior art. Applicants have not set forth any steps in the body of the claim to distinguish over the prior art. For example, the steps in the method of manufacturing aspect of the claim do not mention applying the adhesive backing to the card, nor are any steps recited relating to forming the reference objects into a roll or pad.

Comments

18. The following prior art references are of interest: Matsuo, et al., U.S. Pat. No. 5,852,675 (22 Dec. 1998), discloses a color chart for image correction which is removably adhered to a patient's skin, and which was disclosed in connection with Applicant's Information Disclosure

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Statement. Sheedy, U.S. Pat. No. 5,661,539 (26 Aug. 1997), which discloses a reference card with removable adhesive such that it may be temporarily attached to a monitor. Sheedy does not explicitly disclose a camera or photography, since the device is used to determine the ergonomic position of a monitor. Morrison, U.S. Pat. No. 4,575,124 (11 Mar. 1986), discloses a grey scale chart for cameras (Fig. 1). Koka, et al., U.S. Pat. No. 4,760,447 (26 Jul. 1988), discloses calibration patterns for cameras. Miller, U.S. Pat. No. 4,492,474 (8 Jan. 1985), discloses a target card for photographic printing. Macfarlane, et al., U.S. Pat. No. 6,271,920 (7 Aug. 2001), discloses a color calibration device using adhesive, however, such adhesive appears not to be removable (col. 15, lns. 55-60; Fig. 6C and 6D).

CONCLUSION

19. Applicants' Claims 1-14 are rejected based on the reasons set forth above.
20. Any inquiries concerning this communication from the Examiner should be directed to Vincent P. Barth, whose telephone number is 571-272-2410, and who may be ordinarily reached from 9:00 a.m. to 5:30 p.m., Monday through Friday. The fax number for the group before final actions is 703-872-9306.
21. If attempts to reach the Examiner prove unsuccessful, the Examiner's supervisor is Frank G. Font, who may be reached at 571-272-2415.
22. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1782.



Richard A. Rosenberger
Primary Examiner